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OFFICE OF PETITIONS

In re Patent No. 7,456,219	: DECISION ON REQUEST FOR
Miller et al.	: RECONSIDERATION OF
Issue Date: November 25, 2008	: PATENT TERM ADJUSTMENT
Application No. 10/600,132	: AND NOTICE OF INTENT TO ISSUE
Filed: June 19, 2003	: CERTIFICATE OF CORRECTION
Attorney Docket No. 24852-501 CIP	:

This is a decision on the renewed petition filed on August 28, 2009,¹ which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand four hundred sixty-eight (1468) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein**. The term of the above-identified patent is extended or adjusted by **one thousand four hundred forty-seven (1447) days**.

In the present petition, patentee acknowledges that A Delay is 821 days, B Delay is 890 days, and the overlapping period is 169 days. However, patentee asserts that total period of applicant delay is 74 days, not 95 days.

Specifically, patentee disputes the period of reduction of 21 days under 37 CFR 1.704(c)(10) for the filing of the IDS on September 18, 2008. Patentee argues:

¹ This petition was timely filed within two months of the decision on the request for reconsideration of patent term adjustment mailed July 28, 2009.

The Office has maintained the reduction of 21 days of delay allegedly attributed to Applicants under 37 C.F.R. §1.704 for the filing of an Information Disclosure Statement ("IDS") on September 18, 2008. The Decision of July 28, 2009 states that the IDS filed on September 18, 2008 did not include the proper statement under 37 C.F.R. §1.704(d) and upheld the 21 day reduction for this reason. Applicants believe that the 21 day reduction should be withdrawn, because the September 18, 2008 IDS was filed within 30 days of the receipt of the information in the IDS from a foreign patent office. See, e.g., Exhibit A submitted in the Application filed on December 16, 2008. Whether the IDS statement of September 18, 2008 was in proper form is purely a matter of procedure. What is undisputed here is that the IDS was, in fact, filed within 30 days of receipt of the information in the IDS from a foreign patent office and the factual circumstances of the IDS filing within the 30 day time period alone warrants withdrawal of the 21 day reduction, despite the absence of the exact, specific language of 37 C.F.R. 1.704(d) in the IDS statement of September 18, 2008. Applicants respectfully request withdrawal of the 21 day reduction in patent term adjustment erroneously attributed to Applicant delay.

Petition, 08/28/09, p. 3.

It is undisputed that patentee filed the IDS on September 18, 2008, after the mailing of the notice of allowance. A review of the IDS filed September 18, 2008, reveals that it did not include the proper statement under 1.704(d). Specifically, the IDS was accompanied by the following statement:

Applicants hereby certify, as specified in 37 C.F.R. §1.97(e), that the item of information contained in this Supplemental Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than thirty (30) days prior to the filing of this Supplemental Statement.

Emphasis added.

The Office reminds patentee that 37 CFR 1.704(d) was revised, effective May 24, 2004.² The required statement states, in pertinent part, that:

[E]ach item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

(Emphasis added).

Applicants should have mirrored the language as required by 37 CFR 1.704(d). In particular, the Office notes that patentee has still not provided the Office with a statement mirroring the language set forth in § 1.704(d) with the present renewed petition or to date. Thus, the period of reduction of 21 days will remain.

Accordingly, the patent term adjustment is 1447 days (821 days of A delay + 890 days of B delay - 169 days of overlap - 95 days of applicant delay).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentee is given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The submission of the \$200.00 fee for the filing of the present renewed petition is unnecessary and will be refunded. No additional fees are required.

² "Section 1.704(d) [was] amended to change 'cited in a communication' to 'first cited in any communication' in order to clarify that the item must have been first cited in **any communication** from a foreign patent office in a counterpart application **instead of merely being cited in such a communication.**" 69 FR 21704 (Apr. 22, 2004) (Emphasis added).

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand four hundred forty-seven (1447) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,456,219 B2

DATED : Nov. 25, 2008

INVENTOR(S) : Miller et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 1351 days

Delete the phrase "by 1351 days" and insert – by 1447 days--

PTA Calculations for Application: 10/600132

Application Filing Date:	06/19/2003	PTO Delay (PTO):	890
Issue Date of Patent:	11/25/2008	Three Years:	0
Pre-Issue Petitions:	604	Applicant Delay (APPL):	234
Post-Issue Petitions:	0	Total PTA (days):	1447
PTO Delay Adjustment:	187		

File Contents History

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83	03/05/2008	STATEMENT FILED INDICATING A LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS			
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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